REMARKS

By the foregoing amendment, claims 1, 3, 4, 10, 11 and 15 have been amended as suggested in the Office action so as to avoid their technical rejection, stated on pages 2-3 of the Office action as indefinite under 35 U.S.C. 112, second paragraph. Accordingly, withdrawal of such rejection is now expected.

Also, claim 11 has been recast in independent form by incorporating therein the statements of its parent claims 1 and 10, without substantive change. Claim 5 has been amended so as to depend from rewritten claim 11, and dependent claims 6 and 8 have been cancelled as redundant.

It is noted from the Office action that the previous rejections of claims 1, 2, 9 and 12-14 under 35 U.S.C. 102(b) and claims 3-5, 7 and 10 on the merits over the prior art references of record under 35 U.S.C. 102/103 are withdrawn in favor of new rejections of claims 1-5, 7, 9, 10 and 12-16 under 35 U.S.C. 103(a) over the same prior art references of record.

In regard to the claims now rejected over the Licht and/or the Ishikawa et al. patents of record, such rejections are believed to be in error for reasons hereinafter pointed out. Claims 1, 11 and 15 are each restricted to introduction of the fire resisting agent to the barrier after its formation, constituting a claim limitation conceded to be a distinction over the disclosure in the Licht patent and in the Ishikawa et al. patent, as stated on pages 4 and 7 of the Office action. However, the Examiner asserts without reference to any evidentiary support, such as another prior art reference, that the latter referred to claim distinction over the single prior art reference relied on is an obvious reversal of prior art process steps. A decision rendered by the Board of Appeals in Ex parte Rubin, 128 USPQ 440, is cited as allegedly sanctioning the Examiner's foregoing referred to type of obviousness judgment.

First, the case of Ex parte Rubin, 128 USPQ 440 relates to double patenting rejections rather than the standard for rendering an obviousness judgment under 35 U.S.C. 103, for which reason it does not sanction the Examiner's improper type of obviousness judgment. Thus, according to a more recent decision of the Board of Appeals in Ex parte Millard C. Totman, rejections under 35 U.S.C. 103 were reversed because of a basic inadequacy in the evidence of obviousness submitted by the Examiner, in lacking any teaching or suggestion found in some cited prior art reference as now called for in Section 706.02(j) M.P.E.P. Also the claim limitation concedly lacking in each of the prior art references relied on in the present case, involving in-situ infusion of the fire resisting agent into the barrier layer before its attachment to the substrate, achieves an unexpectedly beneficial result in reducing installational costs as referred to on page 1, lines 10-14 of the original specification. The Examiner's reliance on hindsight speculation to render an obviousness judgment is thereby now traversed on this account, pursuant to Section 2144.03 M.P.E.P.

In view of the foregoing, favorable reconsideration is requested with respect to amended claims 1, 11 and 15 together with claims 2, 3, 4, 5, 7, 10, 12, 13, 14 and 16 dependent therefrom. An allowance of the application based on such claims is therefore expected in due course.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE IN THE CLAIMS

Rewrite claims 1and 10 as follows:

1. (Twice Amended) A process of forming a composite structure by applying a barrier to an underlying substrate during fabrication of the composite structure, including the steps of: introducing a fire resisting agent to the barrier after formation [thereof] of the barrier; and attaching the barrier to the substrate before completing the fabrication of the composite structure.

10. (Twice Amended) The process as defined in claim 1, wherein said formation of the barrier includes the step of: applying a waterproofing cover skin [thereto] to the barrier through which the fire resisting agent is infused before said attaching [thereof] of the barrier to the substrate.

Amend claims 3-5 as follows:

3. (Twice Amended) The process as defined in claim 2, wherein said formation of the barrier includes the step of: applying a waterproofing cover skin [thereto] to the barrier through which the fire resisting agent is infused.

4. (Twice Amended) The process as defined in claim 3, wherein said attaching of the barrier is performed by bonding [thereof] of the barrier to the substrate.

5. (Twice Amended) The process as defined in claim [4] 11, wherein the barrier is an intumescent mat and the fire resisting agent is a phenolic resin.

Cancel claims 6 and 8 without prejudice.

Rewrite claim 11 as follows:

11. (Twice Amended) [The] A process [as defined in claim 10, wherein the] of forming a composite structure including: formations of a barrier with a waterproofing cover skin; applying the barrier to an underlying substrate during formation of the composite structure; introducing a fire resisting agent by infusion into the cover skin after formation of the barrier; and attaching the barrier to the substrate by bonding before completing the fabrication of the composite structure; said waterproofing cover skin [is] being aluminum foil and said bonding [involves] involving application of a silicone adhesive between the barrier and the substrate.

Amend claim 15 as follows:

15. (Amended) A process for protective fabrication of a composite structure by applying a barrier layer after formation [thereof] to an underlying substrate, the improvement residing in the steps of: introducing a fire resisting agent by in-situ infusion into the barrier layer after said formation [thereof] of the barrier layer; and attaching the barrier layer with the fire resisting agent infused therein to the substrate before completing said fabrication of the composite structure.